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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

TUNG, M

ART UNIT PAPER NUMBER

2901

11

DATE MAILED: 02/04/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 10/21/96
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) figure descriptions is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. Group II and III (Figs.3-6, 8, 9) are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for nonelected invention. Election was made without traverse in Paper No. 10. Upon review of the restriction requirement, Fig.7 was misidentified in the office action mailed 9/16/96 as the same embodiment as Fig.1. Fig.7 is a separate embodiment and is appropriately associated with Group I.

2. In light of the cancellation of Groups II and III, figure views 3-6, 8 and 9 must be cancelled from the drawing, and their corresponding figure descriptions 3-6, 8 and 9 must be cancelled from the specification. The original figure views 1, 2 and 7 must be labeled Figs. 1-3, respectively, and their corresponding figure descriptions must be renumbered Figs. 1-3, respectively. Correction is required. 35 U.S.C. § 112 paragraph 2, 37 C.F.R. § 1.117.

3. For a clear description of the figure views, the corresponding figure descriptions must be amended to read:

--Fig.1 is a front view of a paper tray icon  
for computer display;

Fig.2 is a front view of a second  
embodiment thereof;

Fig.3 is a front view of a third embodiment  
thereof.--

Correction is required. 35 U.S.C. § 112 paragraph 2, 37 C.F.R. § 1.117.

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4. The claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The claim is indefinite because of the use of the phrase "or the like" following the title. Cancellation of this phrase in the claim and each occurrence of the title throughout the papers, except the declaration, will overcome the rejection. *Ex parte Sussman*, 8 USPQ2d 1443 (BPAI 1988), *Ex parte Pappas*, 23 USPQ2d 1636 (BPAI 1992) and 37 CFR 1.153.

5. The claim is rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter. 35 U.S.C. 171 defines the proper subject matter for a design patent:

Whoever invents any new, original and ornamental design for an *article of manufacture* may obtain a patent therefor, subject to the conditions and requirements of this title. [emphasis added]

To be considered statutory subject matter under 35 U.S.C. 171, a claimed design must be embodied in "an article of manufacture."<sup>1</sup> The phrase "an

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<sup>1</sup>In re Zahn, 617 F.2d 261, 268, 204 U.S.P.Q. 988, 995 (CCPA 1980).

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article of manufacture" has been interpreted to be a tangible object or physical substance.<sup>2</sup>

6. A design may be embodied in an article of manufacture (1) as a configuration for an article of manufacture, (2) as a surface ornamentation for an article of manufacture, or (3) a combination of both. *Gorham v. White*, 81 U.S. 511, 525 (1871); *In re Schnell*, 46 F.2d 203, 209 (CCPA 1931); MPEP § 1502.

7. Pursuant to the guidelines for examination of design patent applications for computer generated icons<sup>3</sup> a design for a computer generated icon may be considered statutory subject matter if the following conditions are present:

- 1) the computer screen, monitor, other display panel, or portion thereof is shown in broken or solid lines with the icon displayed on it, and
- 2) the claim is directed to the subject matter as embodied in an article of manufacture.

The subject matter of the instant application does not meet these conditions.

Consequently, a design for a computer generated icon per se is unpatentable

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<sup>2</sup>See *Henry Hanger & Display Fixture Corp. of America v. Sel-O-Rak Corp.*, 270 F.2d 635,640, 123 U.S.P.Q. 3, 6 (5th Cir. 1959); *Pelouze Scale & Mfg. Co. v. American Cutlery Co.*, 102 F. 916, 918 (7th Cir. 1900). *Kim Craftsmen, Ltd. v. Astra Products, Inc.*, 212 U.S.P.Q. 268 (D.N.J. 1980); 1 E. Lipscomb, *Walker on Patents*, 2:11 (1984), 1 W. Robinson, *The Law of Patents*, 200 (1890).

<sup>3</sup>1185 O.G. 60, 61 F.R. 11380 (1996).

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since it is not embodied in a specific article of manufacture.<sup>4</sup> Be advised that the claim might be fatally defective; that is, it might not be possible to amend the specification, drawings and/or claim to meet the conditions set forth above without introducing new matter under 35 U.S.C. 112, first paragraph.

8. The claim is rejected under 35 U.S.C. 112, second paragraph; and 35 U.S.C. 171.

9. The references are cited as cumulative art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Tung, whose telephone number is (703)305-3105. The examiner can normally be reached on Tuesday-Friday from 7:30 to 5:00. The examiner can also be reached on alternate Mondays. The FAX phone number for this group is (703)308-2742. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3293.

mht  
February 2, 1997

  
M. H. TUNG  
EXAMINER  
ART UNIT 2901

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<sup>4</sup>Ex parte Strijland, 26 U.S.P.Q.2d 1259 (BdPatApp & Inter 1992), Ex parte Tayama, 24 U.S.P.Q.2d 1614 (BdPatApp & Inter 1992), Ex parte Donoghue, 26 U.S.P.Q.2d 1266 (BdPatApp & Inter 1992); Ex parte Donoghue, 26 U.S.P.Q.2d 1271 (BdPatApp & Inter 1992), and Ex parte Donaldson, 26 U.S.P.Q.2D 1250 (BdPatApp & Inter 1992).